



#11

(N.E.)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

I hereby certify pursuant to 37 C.F.R. § 1.8(a)(1) that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

on 1 March, 2004.

Donald E. Schreiber

Dated: 1 March, 2004

Donald E. Schreiber
A Professional Corporation
Post Office Box 64150
Sunnyvale, CA 94088-4150
(408) 541-9168

Serial No. : 09/429,174 Confirmation No. (None)

Applicants : Jung-Chih Huang, et al.

Filed : October 28, 1999

Title : PRE-BOOT SECURITY CONTROLLER

TC/A.U. : 2134

Examiner : Christopher J. Brown

RECEIVED

MAR 09 2004

Technology Center 2100

Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

Sir:

This communication is submitted in response to an Office Action dated January 14, 2004.

Appl. No. 09/429,174
Response Dated March 1, 2004
Reply to Office Action Dated January 14, 2004

Introductory Remarks

All rejections of claims set forth in the Office Action dated January 14, 2004, rely, either in whole or in part, upon combining:

1. United States Patent no. 4,604,708 entitled "Electronic Security System for Electronically Powered Devices" that issued on August 5, 1986, on a patent application filed by Gainer R. Lewis ("the Lewis patent"); with
2. United States Patent no. 5,251,304 entitled "Integrated Circuit Microcontroller With On-Chip Memory and External Bus Interface and Programmable Mechanism for Securing the Contents of On-Chip Memory" which issued on a patent application filed in the names of James M. Sibigtroth, Michael W. Rhoades, George G. Grimmer, Jr. and Susan W. Longwell ("the Sibigtroth, et al. patent").

As established by the accompanying "Declaration of Brian Oh" and as explained in greater detail below, combining the disclosure of the Sibigtroth, et al. patent with that of the Lewis patent:

1. does not increase the illusion of security provided by the invention disclosed in the Lewis patent; and
2. in one way of combining the disclosures, produces a combination which:
 - a. does not meet all the limitations expressly set forth in independent claim 1; and

Appl. No. 09/429,174
Response Dated March 1, 2004
Reply to Office Action Dated January 14, 2004

- b. is inoperable for the intended purpose expressly set forth in the Lewis patent.

Appl. No. 09/429,174
Response Dated March 1, 2004
Reply to Office Action Dated January 14, 2004

AMENDMENTS

There are no **Amendments to the Specification.**

There are no **Amendments to the Claims.**

There are no **Amendments to the Abstract of the Disclosure.**

There are no **Amendments to the Drawings.**

Remarks/Arguments begin on page 5 of this Response.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : 09/429,174 Confirmation No. (None)
Applicants : Jung-Chih Huang, et al.
Filed : October 28, 1999
Title : PRE-BOOT SECURITY CONTROLLER
TC/A.U. : 2134
Examiner : Christopher J. Brown

Docket No. : 2139
Customer No.: 23320

RECEIVED

MAR 09 2004

Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

Technology Center 2100

Sir:

Transmitted herewith are:

1. a full and complete response to an Office Action dated January 14, 2004; and
2. a Declaration of Brian Oh.

Small entity status under 37 C.F.R. §§ 1.9 and 1.27 has been established for this application by a previously submitted verified statement.

Applicants believe that no additional fee is required for filing the accompanying response.

It appears that this response to the Office Action dated January 14, 2004, is being timely filed. However, if this response is deemed not to be timely filed, then pursuant to the relevant provision of 37 C.F.R. § 1.136, the Applicants hereby conditionally petition for an extension of time sufficient to make the response timely.

///

///

Appl. No. 09/429,174
Response Dated March 1, 2004
Reply to Office Action Dated January 14, 2004

If any additional fee is due, the Commissioner of Patents is hereby authorized to charge any deficiency or credit any surplus in the enclosed fee to Deposit Account No. 19-0735. A duplicate copy of this transmittal letter is enclosed herewith.

Respectfully submitted,


Donald E. Schreiber
Reg. No. 29,435

Dated: 1 March, 2004

Donald E. Schreiber
A Professional Corporation
Post Office Box 2926
Kings Beach, CA 96143-2926

Telephone: (530) 546-6041

Attorney for Applicants